THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GUERINO G. SACRIPANTE, MELVIN D. CROUCHER, and STEPHAN V. DRAPPEL

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Appeal No. 96-2574
Application 08/264,264[1]

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ON BRIEF

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Before: SOFOCLEOUS and GARRIS, Administrative Patent Judges, and McKELVEY, Senior Administrative Patent Judge.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

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[1] Application for patent filed June 23, 1994. The application is said to be a division of application 08/144,964, now U.S. Patent 5,348,831. The real party in interest is Xerox Corporation.

The appeal is from a decision of the Primary Examiner rejecting claims 17-18, 20, 23-24 and 27-28 as being unpatentable under 35 U.S.C. § 103 over Japanese patent 06-111627, published April 22, 1994. We reverse.

The difference between the claimed process and the process described in the Japanese patent is that applicants claim the use of a polyoxyalkylenediamine (second formula in claim 17) to make a polyesterimide resin whereas the Japanese patent describes only the use of alkylene diamines (e.g., ethylene diamine and trimethylenediamine) and aromatic diamines (e.g., 4,4'-diamino-diphenyl methane and 4,4'-diaminodiphenyl ether) (translation, pages 12-13). On the record before us, we find no reason (sometimes referred to as a teaching, a suggestion or motivation), for substituting a polyxoyalkylenediamine in the process described in the Japanese patent for making polyesterimides.

To be sure there is an unchallenged statement by the examiner (final rejection, page 4) that "the use of polyoxyalkylenediamines to produce polyesterimides is well known in the art." However, the mere fact that a polyoxyalkylene-diamine may have been used to make some

otherwise unidentified polyesterimide does not establish that it would have been obvious to use a polyoxyalkylenediamine in the process described by the Japanese patent. Compare In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In large measure the examiner has bottomed his rejection on In re Durden, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985). More to the point, in our view, is the rationale set out in In re Ochiai, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995).

REVERSED

MICHAEL SOFOCLEOUS)
Administrative Patent Judge)
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BRADLEY R. GARRIS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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)
FRED E. McKELVEY, Senior)

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cc:

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